

### REMARKS

Claims 1-17 remain in the application. The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Moreover, the amendment or cancellation of claims herein is without prejudice to pursuing claims of different scope by way of continuing Application. Reconsideration of this application is respectfully requested.

### U.S.C. 103

Claims 1-17 are rejected under U.S.C. §103(a) as being anticipated Dea et al. (U.S. Patent No. 5,742,833, hereinafter Dea) in view of Goodman et al. (U.S. Patent Application No. 2002/0097720, hereinafter Goodman). Applicants respectfully traverse the rejection.

It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2142). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

Applicants respectfully traverse the rejection because there is no suggestion or motivation contained in the references to combine them.

Before obviousness may be established, the Office Action *must show specifically* the principle, known to one of ordinary skill that suggests the claimed combination. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In other words, the Examiner *must explain* the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention. *Id.* The factual question of motivation is material to patentability and *cannot be resolved based on subjective belief and unknown authority*. *Id.* at 1344. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577

(Fed. Cir. 1984). The critical inquiry is whether there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. Fromson v. Advance Offset Plate, 755 F.2d 1549, 1556 (Fed. Cir. 1985). The *Office Action fails to show either a suggestion in the art or a compelling motivation based on sound scientific principles to combine the references and therefore the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn*. Applicants respectfully submit that there is no suggestion to combine the references, and if they could be properly combined, do not lead to the Applicants' invention.

Dea teaches a method of providing for improved energy efficiency in a network, particularly a data processing system (column 3 lines 13-14, column 4 lines 61-67). Dea goes on to teach an Ethernet network and the monitoring and transmission of packets over the Ethernet network to facilitate improved energy efficiency in computers connected to the Ethernet network (column 7 line 66 to column 8 line 16, column). Dea teaches TCP/IP and IPX, but does NOT teach or suggest the use of a CAN bus, which is significantly different from an Ethernet network. Primarily, a CAN bus does not use packets, as does the Ethernet network.

Goodman teaches an implementation of a nodal system in a storage library. The storage library includes accessor node and processor node connected by a CAN bus. Gripper electronics move a gripper assembly in an X-Y pattern along with a robotic hand in order to grab and insert storage cartridges from a library into a processing device [0026].

There is NOTHING in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination cited by the Examiner.

The method of providing improved energy efficiency of Dea does not hint or suggest a combination with the nodal library system taught by Goodman. Further, the nodal library system of Goodman does not teach or suggest a combination with the method of improving energy efficiency of Dea. The Examiner alleges that Dea and Goodman are analogous arts and in the same field of endeavor. Applicants respectfully disagree. The method of providing improved energy efficiency in computers connected via an Ethernet network has absolutely nothing to do with Goodman's nodal system in a storage library, where a CAN bus is used. Controller Area Network (CAN) is a multicast shared serial bus standard for connecting electronic control units (ECUs). CAN was specifically designed to be robust in electromagnetically noisy environments. Although initially created for automotive purposes (as a vehicle bus), it may be used in other *embedded control applications* (e.g., industrial) that may be subject to noise. This is contrasted

with *Ethernet, which is a frame-based network that utilizes packets*. Further, a bus, or a CAN bus is a subsystem that transfers data or power between computer components in a computer, whereas Ethernet does NOT. This is contrasted with Dea, which teaches a LAN between multiple computers merely using Ethernet, which is conceptually and technologically non-analogous to a CAN bus.

Applicants' assert that the cited art of Dea and Goodman are not in the same field and would not both be known to a person of ordinary skill in the art in the field of Applicant's invention. There is no motivation in either Dea or Goodman to combine the two, and any assertion to the contrary is impermissible hindsight reconstruction based on Applicant's own teachings. Applicant's position is further strengthened by the differences between a CAN bus as taught by Goodman, and the packet based network taught by Dea.

Applicants respectfully request that the rejection be dropped and the claims proceed to allowance.

#### **Summary**

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to 502117,  
Motorola, Inc.

Respectfully submitted,

DATE: 01/23/2007

SEND CORRESPONDENCE TO:

Motorola, Inc.  
Law Department  
1303 East Algonquin Road  
IL01/3rd  
Schaumburg, Illinois 60196  
Customer Number: 23330

By: /Kevin D. Wills/

Kevin D. Wills  
Attorney of Record  
Reg. No.: 43,993  
Telephone: 480-732-5364  
Fax No.: 480-732-2402  
Email: Kevin.Wills@motorola.com